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OFFICE OF PETITIONS

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In re Application of :
Dah-Ben Liang et al. : DECISION ON PETITION
Application No. 09/637,764 :
Filed: August 10, 2000 :
Atty Docket No. 36912/CM/S61 :
:

This is a decision on the petition filed on November 5, 2008, which is being treated as a petition under 37 CFR 1.183 seeking waiver of 37 CFR §§ 1.67 and 1.175 where it requires that a supplemental declaration be executed by a named inventor.¹

The petition is before the Office of Patent Legal Administration for decision.

The petition is **GRANTED**.

BACKGROUND

1. On August 10, 2000, application No. 09/637,764 was filed for reissue of U.S. Patent No. 5,791,422.
2. On November 5, 2008, petitioner submitted signed copies of substitute declarations for reissue patent application from Dah-Ben Liang, Alysia C. White, Jiinjen Albert Sue and a blank copy from Zhigang Fang.
3. Also on November 5, 2008, the present petition, taken under 37 CFR 1.183, was filed. Petitioners assert that joint inventor Zhigang Fang has refused to sign the substitute declaration.

DECISION ON PETITION UNDER 37 CFR 1.183
TO WAIVE §§ 1.67 AND 1.175

¹ Once an application has received a fully executed oath or declaration and been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. Rather, the remedy for treating an inventor's refusal to also sign a supplemental oath or declaration is waiver of 37 CFR 1.67. See MPEP 603.

Petitioners state that joint inventor Zhigang Fang has constructively refused to sign the substitute reissue declaration. Counsel's patent administrator, Inez Cameron, states that,

"2. On June 4, 2008, I received a copy of a letter from our Patent Attorney, Constantine "Gus" Marantidis, reporting a Final Office Action that issued on the above-referenced reissue application, as well as copies of a Substitute Declaration for Reissue Patent Application to be signed by the joint inventors;

3. On or about June 10, 2008, I forwarded a copy of a Substitute Declaration for Reissue Patent Application ("Substitute Declaration") to joint inventor, Zhigang Fang, also known as Zak Fang. A true and accurate copy of the Substitute Declaration forwarded to Mr. Fang is attached hereto in Appendix A.

4. On June 27, 2008, I sent an email to Mr. Fang inquiring if he had received the Substitute Declaration. A true and accurate copy of this email is attached hereto in Appendix B;

5. On August 7, 2008, I sent a further email providing a reminder to Mr. Fang to sign the Substitute Declaration and return it to me. A true and accurate copy of my email of August 7, 2008 is attached hereto in Appendix C;

6. On October 22, 2008, I sent Mr. Fang an email providing a further reminder. A true and accurate copy of my email of October 22, 2008 is attached hereto in Appendix D;

7. On October 22, 2008, I received a reply from Mr. Fang stating that he would "take care" of the Substitute Declaration early next week. A true and accurate copy of Mr. Fang's email of October 22, 2008 is attached hereto in Appendix E;

8. On October 27, 2008, I received another email from Mr. Fang advising that he can not sign the Substitute Declaration. A true and accurate copy of Mr. Fang's email of October 27, 2008 is attached hereto in Appendix F;

9. On October 27, 2008, Mr. Fang had a telephone conversation with Mr. Marantidis. Mr. Marantidis advised me that Mr. Fang may reconsider signing the Substitute Declaration. Mr. Marantidis forwarded to me a copy of the Amendment After Final action showing the claims as currently pending in the application, as well as a copy of the previous Substitute Declaration executed by Mr. Fang to be forwarded to Mr. Fang for his review. On October 27, 2008, I forwarded both of these documents to Mr. Fang. A true and accurate copy of my email to Mr. Fang, including true and accurate copies of the attachments are attached hereto in Appendix G;

10. On November 6, 2008, I left a follow up voicemail to Mr. Fang, inquiring about the status of the Substitute Declaration; and

11. To this date, I have not received a copy of the signed Substitute Declaration from Mr. Fang."

In view of the efforts recounted in the petition to obtain the signature of Zhigang Fang on the substitute declaration in compliance with 37 CFR 1.175, and the apparent refusal to sign, it is agreed that justice would be served by waiving the requirement for the signature of joint inventor Zhigang Fang on the substitute declaration filed on November 5, 2008.

CONCLUSION

1. The petition is granted.
2. Jurisdiction over the application is being forwarded to Technology Center Art Unit 3672 for further processing.
3. Telephone inquiries related to this decision should be directed to Irvin Dingle at (571) 272-3210.
4. Inquiries regarding petition status or general petition information are handled by the Office of Petitions staff at (571) 272-3282.

/Kenneth M. Schor/

Kenneth M. Schor
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